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| 09/717,448  | 11/20/2000  | Dale F. McIntyre     | 81884F-P            | 1988             |
| 1333  | 7590        | 08/11/2004           | EXAMINER            |                  |
| PATENT LEGAL STAFF<br>EASTMAN KODAK COMPANY<br>343 STATE STREET<br>ROCHESTER, NY 14650-2201 |             |                      | RHODE JR, ROBERT E  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3625                |                  |

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,448

Applicant(s)

MCINTYRE ET AL.

Examiner

Rob Rhode

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Applicant amendment of 5-12-2004 amended the specification and claim 8 as well as traversed rejections of Claims 1 - 16.

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Currently, claims 1- 16 are pending.

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 8, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fellegara (US 5,845,166) in view of Safai (US 6,167,469) and further in view of Garfinkle (US 6,133,985).**

Regarding claims 1 (previously amended), 8 (currently amended) and 9 (previously amended), Fellegara teaches a method of providing image goods from a service provider and/or services to a plurality of customers located at different locations, comprising; substantially simultaneously capturing an image both electronically and on a photosensitive media by a customer using a camera, said electronic image comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said

photosensitive media (see at least Abstract and Figure 19). Please note that little patentable weight is given to the phrase "that identifies that the digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photo sensitive media". The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional

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descriptive material, which does not patentably distinguish the applicant's invention from Fellegara. Thereby, the non-fictional descriptive material is directed only to the content of the identification data (. i.e. "that identifies that the digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photo sensitive media" - which is stored data) and does not affect either the structure or method/process of Fellegara, which leaves the method and system unchanged (see MPEP 2106).

However, Fellegara does not specifically disclose and teach a method of forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media. Nor does Fellegara disclose and teach a method for transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted.

On the other hand and in the same area of using a camera to capture images, Safai teaches a method of forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said

photosensitive media (see at least Abstract, Col 10, lines 25 – 27 and Col 13, line 20) as well as a method for transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted (see at least Col 13, lines 22 – 23 and Col 14, lines 13 - 15). Please note that Safai does not specifically disclose photosensitive media. However, Safai does disclose a service provider and production of prints. Moreover, Fellegara does disclose photosensitive media, which it is well known in the art that the media has to be sent to a service provider for development of prints – unless of course the individual is a professional photographer with their own film development capability. In that regard, it would have been obvious to one of ordinary skill in the art to have extended the method of Safai to have included providing images on photosensitive media. Thereby, the individual will be able to have their virtual images as well as photosensitive media developed by a single service provider, which will increase their satisfaction as result of the “one stop shopping”. Furthermore, the phrase “prior to execution of providing goods or services” is obvious. For example, in developing photosensitive media at a physical as well as a virtual store, one has to provide identifying data “prior to execution of providing goods or services” – because the goods or service can not be provided without this information such as number of prints, size, etc.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Fellegara with the method of Safai to have enabled a method of providing image goods from a service provider and/or services to a plurality

of customers located at different locations, comprising; substantially simultaneously capturing an image both electronically and on a photosensitive media by a customer using a camera, said electronic image comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photosensitive media; forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media; and transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted – in order to download digital images as well as forwarding photosensitive media for development at a service provider and including digital images being sent to a friend. Fellegara discloses a method of providing image goods from a service provider and/or services to a plurality of customers located at different locations, comprising; substantially simultaneously capturing an image both electronically and on a photosensitive media by a customer using a camera, said electronic image comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photosensitive media (Abstract). Safai disclose a method of forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media as well as a method for transmitting said electronic images to said third party along with said identifying data with respect to

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said images transmitted (see at least Abstract, Col 10, lines 25 – 27 and Col 13, line 20). Therefore, one of ordinary skill in the art would have been motivated to extend the method of Fellegara with a method of forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media as well as a method for transmitting said electronic images to

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said third party along with said identifying data with respect to said images transmitted

In this manner, the customer can transmit information (i.e. in various forms) that identifies the images with specific data in order to fully identify the images for the potential printing of higher quality images. Thereby, the customer can provided the identifying data for the images, which will provide clear designation of the images as well as providing an opportunity to obtain a quote regarding the cost of developing these photos – if desired.

The combination of Fellegara and Safai teach key limitations of the applicant's invention.

However, the combination does not specifically disclose and teach a method of placing an order by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed.

On the other hand in the same area of camera's and online developing and ordering, Garfinkle teaches a method of placing an order by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed (see at least Abstract and Col 8, lines 23 - 38).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Fellegara and Safai with the method of Garfinkle to have enabled a method placing an order for goods by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed – in order to allow additional orders from parties other than the photographer. The combination of Fellegara and Safai disclose a method of providing image goods from a service provider and/or services to a plurality of customers located at different locations, comprising; substantially simultaneously capturing an image both electronically and on a photosensitive media by a customer using a camera, said electronic image comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photosensitive media; and forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media as well as a method for transmitting said electronic images to said



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third party along with said identifying data with respect to said images transmitted.

Garfinkle discloses a method of placing an order by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed (see at least Abstract and Col 8, lines 23 - 38). Therefore, one of ordinary skill in the art would have been

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motivated to extend the combination of Fellegara and Safai with a method for placing an order by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed. With these features, the customer is able to share photos with others as well as allow them to order these too – if desired. In this manner, the photographer's satisfaction will be increased with these features of sharing with others as well as allowing them to order and thereby increasing the probability that the photographer and others will use these provided services in the future. Furthermore, these features will also increase the amount of potential revenue for the service provider.

Regarding claim 16, Garfinkle teaches a method wherein said high resolution image comprises a digital image (Col 8, line14).

**Claims 2 – 5 and 10 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fellegara, Safai and Garfinkle as applied to claims 1 and 9 above, and further in view of Sheridan (US 5,760,917).**

The combination of Fellegara, Safai and Garfinkle substantially disclose and teach the applicant's invention.

However, the combination of Fellegara, Safai and Garfinkle does not specifically disclose and teach a method wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images; and wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image; and wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded – as well as wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received.

On the other hand and regarding claim 2 and related claim 10, Sheridan teaches a method wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images (Col 2, lines 58 – 67).

Regarding claim 3 and related claim 11, Sheridan teaches a method wherein said customer advises said service provider that said image has been forwarded to said third

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party for potential placement of an order with respect to said image (see at least Abstract).

Regarding claim 4 and related claim 12, Sheridan teaches a method wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded (Col 2, lines 28 – 30).

Regarding claim 5 and related claim 13 wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received. Please note, Sheridan does not specifically teach regarding “order confirmation”, this capability of order confirmation for online shoppers – regardless of the party involved in the ordering is old and well known to one of ordinary skill in the art. Moreover, this statement regarding old and well known was contained in the previous Final Rejection. As result, if the applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following is admitted prior art: wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Fellegara, Safai and Garfinkle with the method of Sheridan to enable providing wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images; and wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image; and wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded as well as wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received – in order to have provided the capability for the service provided to ease the online shopping process for all parties. The combination of Fellegara, Safai and Garfinkle disclose a method of providing image goods from a service provider and/or services to a plurality of customers located at different locations, comprising; substantially simultaneously capturing an image both electronically and on a photosensitive media by a customer using a camera, said electronic image comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photosensitive media; forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media; transmitting said electronic images to said third party along with

said identifying data with respect to said images transmitted; and placing an order by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed. Sheridan discloses a method wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images; and wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image; and wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded – as well as wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received (Abstract, Col 2, lines 28 – 67). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Fellegara, Safai and Garfinkle with a method wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images; and wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image; and wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded. In that regard and with these added features, the online party's satisfaction will be increased

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and thereby increasing the probability that they will return in the future for their film developing needs as well as recommending the site to others.

**Claims 6 - 7 and 14 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fellegara, Safai and Garfinkle as applied to claims 1 and 9 above, and further in view of Fredlund (US 5,666,215).**

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The combination of Fellegara, Safai and Garfinkle substantially disclose and teach the applicant's invention.

However, the combination of Fellegara, Safai and Garfinkle does not specifically disclose and teach a method wherein said customer provides a predetermined amount of credit which may be charged to said customer with respect to ordering of goods and/or services by said third party and wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images.

On the other hand and regarding claim 6 and related claim 14, Fredlund teaches a method wherein said customer provides a predetermined amount of credit which may be charged to said customer with respect to ordering of goods and/or services by said third party (Col 2, lines 40 – 44).

Regarding claim 7 and related claim 15, Fredlund teaches a method wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images (Col 2, lines 45 – 56).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Fellegara, Safai and Garfinkle with the method of Fredlund to have enable said customer provides a predetermined amount of credit which may be charged to said customer with respect to ordering of goods and/or services by said third party and wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images – in order to have provided the additionally capabilities for customers to allow others to charge to certain credit limit as well as providing other items to purchase. The combination of Fellegara, Safai and Garfinkle disclose a method of providing image goods from a service provider and/or services to a plurality of customers located at different locations, comprising; substantially simultaneously capturing an image both electronically and on a photosensitive media by a customer using a camera, said electronic image comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of

goods and/or services made using said photosensitive media; forwarding said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media; transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted; and placing an order by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed. Fredlund discloses a method wherein said customer provides a predetermined amount of credit which may be charged to said customer with respect to ordering of goods and/or services by said third party and wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images (Col 2, lines 40 – 57). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Fellegara, Safai and Garfinkle with a method for a method wherein said customer provides a predetermined amount of credit which may be charged to said customer with respect to ordering of goods and/or services by said third party and wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by selecting from pre-designated options provided in addition to said images. In that regard, the customer's satisfaction will be enhanced as well potentially increasing the revenue for the service provided by including additional accessories to be



purchased with each order and thereby potentially increasing the revenue for the service provider.

### ***Response to Arguments***

Applicant's arguments, see amendment, filed 5-12-2004, with respect to the rejection(s) of claim(s) 1 - 16 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Fellegara (US 5,845,166) and Safai (US 6,167,469).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

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**Alexandria, Va. 22313-1450**

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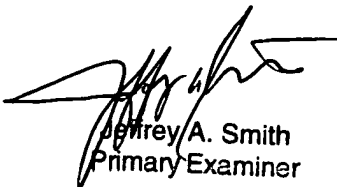
**(703) 872-9306** [Official communications; including  
After Final communications labeled  
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**(703) 746-7418** [Informal/Draft communications, labeled  
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER

  
Jeffrey A. Smith  
Primary Examiner